



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,631	07/28/2003	Fred Monroe	03-748	4899
39310 7590 05/01/2007 MBHB/TRADING TECHNOLOGIES 300 SOUTH WACKER DRIVE SUITE 3200 CHICAGO, IL 60606			EXAMINER AKINTOLA, OLABODE	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/628,631	MONROE ET AL.	
	Examiner	Art Unit	
	Olabode Akintola	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/05/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the electronic exchange" in the second line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3691

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 10, 11 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Garber (U.S. Patent No. 5963923) (hereinafter referred to as Garber).

Re claims 1, 10, 11, 22 and 29: Garber teaches a method for sending an order to an electronic market, comprising: sending an order on behalf of a trader from a first electronic market (Fig. 2, RN {33: *futures market*}) to a second electronic market (Fig. 2, {35: *options market*}, col. 4, lines 5-8: "*facilitate intermarket trading*"), wherein the first electronic market comprises a first computerized matching process that is configured to automatically match bids and offers received from remote client devices to trade a first tradable object and the second electronic market comprises a second computerized matching process that is configured to automatically match bids and offers received from remote client devices to trade a second tradable object and wherein the second tradable object is different from the first tradable objects (col. 4, lines 38-42), such that the action of sending the order is taken on behalf of the trader by the first electronic market itself using a microprocessor executing one or more instructions (col. 4, lines 5-8 & lines 32-44, col. 6, lines 45-52).

Re claim 2: Garber teaches the step of sending is performed when a condition is satisfied (col. 6, lines 45-55)

Re claim 3: Garber teaches the step of receiving a first order at the first electronic market (col. 4, lines 32-36).

Art Unit: 3691

Re claim 4: Garber teaches the step wherein the condition comprises at least a portion of the first order being filled (col. 6, lines 45-55).

Re claim 5: Garber teaches the step of receiving a market event request message at the first electronic market that establishes a condition (col. 8, lines 14-27).

Re claim 6: Garber teaches the step wherein the condition is in the form of a lookup table (col. 8, lines 20-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-8, 23-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Lupien et al. (U.S. Patent No. 5101353) (hereinafter referred to as Lupien).

Art Unit: 3691

Re claim 7-8, 23-27 and 30: Garber is as discussed above. Garber does not explicitly teach the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader, wherein the action of sending the message is taken on behalf of the trader by the first electronic market itself. Lupien teaches the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader (col. 3, lines 7-14, col. 6, lines 3-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include the step of sending a message from the first electronic market to the second electronic market instructing the second electronic market to modify the order sent on behalf of the trader as taught by Lupien. One would have been motivated to do this in order to provide an opportunity to adjust a previously submitted order through its own network, other networks or other computerized exchanges.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5963923) in view of Hauk et al. (U.S. Patent Application No. 20030126068) (hereinafter referred to as Hauk).

Re claim 9: Garber is as discussed above. Garber does not explicitly teach the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm. Hauk teaches the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm (section [0066]: *An algorithm for trade matching, based on prorated or FIFO trading match scheme could be incorporated*). It

would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include the step wherein the electronic market comprises a matching engine that matches bids and offers for a given market according to a first-in-first-out (FIFO) matching algorithm as taught by Hauk. One would have been motivated to do this because FIFO matching scheme is old and well known in the art.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber (U.S. Patent No. 5963923) in view of Wilton et al. (U.S. Patent No. 6519574) (hereinafter referred to as Wilton).

Re claim 28: Garber is as discussed above. Garber does not explicitly teach spread trade strategy. Wilton teaches spread trade strategy (col. 3, lines 55-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Garber to include spread trade strategy as taught by Wilton. One would have been motivated to do this because spread trading allows parties to trade one commodity for another commodity.

Response to Arguments

Applicant's remarks filed 2/07/2007 have been fully considered, but upon further review of the Garber references, the examiner maintained the rejection of the independent claims 1 and 22 because the amendment submitted still reads on the Garber reference. Furthermore, the examiner has introduced the Lupien reference in rejecting some of the claims. Examiner has cited particular portions of the references as applied to the claims above for the convenience of the

Art Unit: 3691

applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references (especially the *Lupien* reference) in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

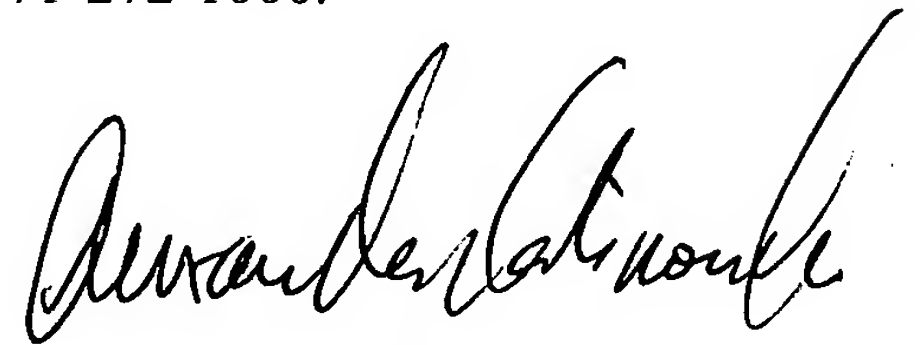
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571- 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER